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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/558,713

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PHILIPS INTELLECTUAL PROPERTY & STANDARDS

P.O. BOX 3001

BRIARCLIFF MANOR, NY 10510

EXAMINER

ZURITA, JAMES H

ART UNIT

PAPER NUMBER

3625

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/558,713	Applicant(s) VAN BREEMEN ET AL.	
	Examiner JAMES ZURITA	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

On 11/29/2005, applicant amended claims 6, 8, 10 and 15.

Priority

Applicant claims priority as a national stage entry of PCT/IB04/50787, International Filing Date: 05/27/2004, which claims foreign priority to 031016082, filed 06/03/2003 with the European Patent Office.

Claim Objections

Claim 18 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim, or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim in independent form and pay the appropriate fees.

Claim 18 is written in dependent format in that they reference a prior method claim. However, the claim does not further limit the steps involved in parent method claim 16. Claim 18 is a dependent claim that does not add, delete or alter any of the steps of the parent claim and thus “fails to further limit the subject matter of a previous claim.”

Claim 18 is also improper because they fail the “infringement test” (see MPEP 608.01(n), Section III). Applying the Infringement test, what is needed to infringe claim 18 is, for example a CD-ROM having computer executable code that if and when executed would cause a computer to do the steps recited in claim 16. However, such a

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CD-ROM would not infringe the method steps of claim 16 since the CD-ROM itself never performs any of the active steps required by the method of claim 16. In other words, mere possession of such a CD-ROM would infringe claims claim 18 but would not infringe claim 16. As such claim 18 is an improper dependent claim.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-15 purport to be directed toward a system, however the bodies of the claims recite only logic or software for a computer, since Applicant identifies apparatus 100 as being composed of various units that are identified as software, as in paragraph 0017, for example. Thus, the claims are directed to functional descriptive material that is not functionally or structurally interrelated to any medium. MPEP § 2106 IV.(g)(1)(a). Prior Art will be interpreted to read on Claims 1-15 where Prior Art discloses structural components that are reasonable capable of performing applicant's intended functions.

Claim 18 is rejected under 35 U.S.C. 101 because the claim is directed to different statutory classes, a computer program product and a method (claim 16). See MPEP 2173.05(p). For purposes of this Examination, the Examiner will interpret claim 18 as being directed to an apparatus. Prior Art will be interpreted to read on Claim 18 where Prior Art discloses structural components that are reasonable capable of performing applicant's intended functions. The Examiner notes that nothing in

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applicant's structure distinguishes the instant invention from the structure of the reference.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-18 are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. For example, Claim 1 does not make sense. According to Fig. 1, units 114, 120, 122 are parts of apparatus 100:

1. A multimedia purchasing apparatus (100) for purchasing a multimedia item (161) over a network (140),

interacting with a user profiling unit (122) containing information on user preferences of multimedia, characterized in that a user negotiation unit (120) is comprised, arranged to autonomously purchase the multimedia item (161) guided by a budget specification (114), and that the user profiling unit (122) is comprised in the multimedia purchasing apparatus (100).

For purposes of Examination, prior art is interpreted to meet the claims where prior art discloses structure reasonable capable of performing the recited functions.

In claim 6, the term "means" appears to be an attempt to invoke 35 U.S.C. 112, sixth paragraph, to recite claim element as a means for performing a specified function.

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However, since the disclosures provide insufficient structural support for the claims, it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967). For purposes of this examination, the claim will be interpreted to not invoke the sixth paragraph. Prior art will be interpreted to read on applicant's claimed limitations where prior art discloses that the structure is reasonable capable of performing the recited functions.

Claim 18 is directed to both an apparatus and the method steps of using the apparatus. MPEP 2173.05(p).

In claim 8, the term "...automatically..." renders the claim indefinite, since actions on a computer can be said to occur automatically.

In claims 1, 16, 17, the term "...autonomously..." renders the claim indefinite, since actions on a computer can be said to occur autonomously.

In claim 5, budget specification is interpreted to refer to unit 114.

In claim 14, the term "...substantially free of charge..."

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims abc, as interpreted, are rejected under 35 U.S.C. 102(b) as being anticipated by Ginter et al. (US 5,892,900).

As per claim 1, Ginter discloses a multimedia purchasing apparatus (Figs 1 and 2, for example) for purchasing a multimedia item (Fig. 2, for example) over a network (fig. 1, for example), interacting with a user profiling unit containing information on user

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preferences of multimedia (Ginter, Col. 26, lines 37-65, for example), characterized in that a user negotiation unit (Ginter, Col. 270, lines 1-65, for example) is comprised, arranged to autonomously purchase the multimedia item guided by a budget specification (Ginter, Col. 271, lines 37-41, for example), and that the user profiling unit (Ginter, Col. 26, lines 37-65, for example) is comprised in the multimedia purchasing apparatus.

As per claim 2, Ginter discloses the budget specification comprises type budgets for different types of multimedia item. Ginter, Col. 59, lines 55-61, for example.

As per claim 3, Ginter discloses that type budgets are subdivided in sub ranges. Ginter, Col. 194, lines 12-47, for example.

As per claim 4, Ginter discloses at least one of the type budgets is associated a quota of multimedia items of the corresponding type. Ginter, Col. 62, lines 19-30, for example.

As per claim 5, Ginter discloses that budget specification(s) comprises budgets for different periods. Ginter, Col. 26, line 66-Col. 28, line 15, for example.

As per claim 6, Ginter discloses that braking means are comprised, arranged to reduce multimedia purchasing when an absolute value of a derivative of a budget spending is above a predefined threshold. Ginter, Col. 26, line 66-Col. 27, line 45, budget limits, for example.

As per claim 7, Ginter discloses a user behavior sensing unit, arranged to obtain information on behavior of a user. See, for example, at least Col. 35, lines 14-53, Col. 43, lines 43-56.

As per claim 8, Ginter discloses that a type budget is automatically determined on the basis of the information of the user behavior sensing unit. Ginter, Col. 223, lines 26-67, metering, usage control, for example.

As per claim 9, Ginter discloses budgets for different periods are determined as a function of a temporal difference between the periods and a time instant (T11). Ginter, Col. 153, lines 59-Col. 154, line 14, duration, for example.

As per claim 10, Ginter discloses an entertainment coordination unit, arranged to produce a schedule of purchased multimedia items. Ginter, Col. 138, lines 1-19, for example.

As per claim 11, Ginter discloses a verification unit arranged to secure user access to the budget specification. Ginter, Col. 26, line 66-Col. 27, line 35, for example.

As per claim 12, Ginter discloses a suggestion reception unit arranged to receive a suggestion to purchase multimedia items. Ginter, Col. 108, lines 9-19, for example.

As per claim 13, Ginter discloses a provider database, comprising data on providers of multimedia content. Ginter, Col. 1, lines 52-Col. 2, line 7, for example.

As per claim 14, Ginter discloses user negotiation unit(s) arranged to purchase linked items of multimedia in which at least one item is substantially free of charge. Ginter, Col. 215, lines 7-30, for example.

As per claim 15, Ginter discloses the user negotiation unit is arranged to propose a package deal for a set of multimedia items to a provider of multimedia content. Ginter, Col. 48, lines 34-63, Col. 278, lines 5-37, for example.

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Claim 16 is rejected on the same grounds as claim 1.

Claim 17 is rejected on the same grounds as claim 16.

Claim 18 is rejected on the same grounds as claim 16.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES ZURITA whose telephone number is (571)272-6766. The examiner can normally be reached on 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on (571)272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James Zurita/
Primary Examiner
Art Unit 3625
15 February 2009